UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/455,542	12/07/99	RESSETTE	5 45112.041

EXAMINER	
LILLING, H	
ART UNIT	**PAPER NUMBER**
1651	7

DATE MAILED: 01/22/01

WILLEM F GADIANO ESQ
MCDERMOTT WILL & EMERY
600 13TH STREET NW
WASHINGTON DC 20005

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95)

U.S. G.P.O. 1999 460-693

1- File Copy

Office Action Summary

Application No.	Applicant(s)
09/455,542	BASSETTE ET AL
Examiner	**Group Art Unit**
DR. HERBERT J. LILLING	1651

X Responsive to communication(s) filed on *Jan 8, 2001*

This action is **FINAL.**

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *THREE* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

X Claim(s) *1-14* is/are pending in the applicat

Of the above, claim(s) *6-14* is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

X Claim(s) *1-5* is/are rejected.

☐ Claim(s) _____ is/are objected to.

X Claims *1-14* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

X Notice of References Cited, PTO-892

X Information Disclosure Statement(s), PTO-1449, Paper No(s). *3 14 00*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Application/Control Number: 09/455,542

Art Unit: 1651

1. Receipt is acknowledged of the response to the restriction requirement filed January 08, 2001.

2. Applicant has elected with traverse Group I, Claims 1-13, drawn to a pharmaceutical composition, classified in several classes 520+, numerous subclasses depending upon the ingredients in the compositions and the eugenol species.

Claims 1-5 read on the elected invention.

Claims 6-14 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention and species, the requirement having been traversed in Paper No. 6 filed January 08, 2001.

The restriction is proper according to the M.P.E.P. The election of species is proper according to the M.P.E.P. Applicant traversed the election species which will be withdrawn if Applicant states on the record that :

> the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The restriction and election requirements have been made FINAL absent the above admission of obviousness.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as anticipated by the following references:

Ref U Kim et al, AN 1998:101607;

Ref V OITA ET AL 1985:427328

Ref W CAPLUS 1991:115063

REF X LUC ET AL 1993:168134

Each of the references is considered to be within the scope of the broad claimed language in view of the following decision:

It is well settled that if a reference reasonably teaches a product which is identical or substantially identical or are produce by identical or substantially identical process, the PTO can require an applicant to prove that the prior art products do not inherently possess the characteristics

of his claimed product. A rationale given for shifting the burden of going forward to applicant is that the PTO does not possess the facilities to manufacture or to obtain and compare prior art products, see **In re Brown**, 459 F.2d 531, 535,173 USPQ 685, 688 (CCPA 1972); **In re Best**, 562 F.2d 1252, 1255,195 USPQ 430, 433-434 (CCPA 1977).

The rejection of the claims will be maintained absent a showing that the compositions of the references are not within the scope of the claimed products. It is acknowledged that the references do not have the claimed use but a new use for an old composition is not patentable in this particular application.

5. **No claim is allowed.**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lilling whose telephone number is (703) 308-2034 and fax number (Art Unit 1651) is (703) 305-7939 or SPE Michael Wityshyn whose telephone number is (703) 308-4743. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

HERBERT J. LILLING
PATENT EXAMINER
GROUP 1600 ART UNIT 1651

H.J.Lilling: HJL
(703) 308-2034
Art Unit 1651
January 17, 2001